

AUS920010833US1

REMARKS

Applicants acknowledge with thanks that claim 55 of the present application is allowed as indicated on the Office Action Summary.

Claims 1-11, 14, 17-22, 32-36, and 45-48 stand rejected under 35 U.S.C § 102(b) as being anticipated by Szlam (U.S. Patent No. 5,511,112). For the reasons set forth below, Szlam does not anticipate Applicants' claims. Claims 12-13, 15-16, 23-24, 31, and 37-38 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112). Claims 25-30, 39-44, and 49 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112) in view of Borland (U.S. Patent 6,178,230). Claims 50-54 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112) in view of Farris *et al.* (U.S. Patent No. 6,122,357). As will be shown below, Szlam, alone or in combination with Borland or Farris, does not teach or suggest methods, systems, and products of the present invention. Claims 1-54 are therefore patententable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-54.

REJECTIONS UNDER 35 U.S.C. § 102 OVER SZLAM

Claims 1-11, 14, 17-22, 32-36, and 45-48 stand rejected under 35 U.S.C § 102(b) as being anticipated by Szlam (U.S. Patent No. 5,511,112). To anticipate claims 1-11, 14, 17-22, 32-36, and 45-48 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that Szlam must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Szlam must enable Applicants' claims. Szlam does not meet either requirement and therefore does not anticipate Applicants' claims.

AUS920010833US1

Szlam Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Szlam does not disclose each and every element of independent claims 1, 11, 14, and 17.

Independent Claim 1

Independent claim 1 claims a method for identifying a context for a call that includes detecting a call request for a call and requesting a context for said call, wherein said context indicates whether an on behalf of action is invoked for said call. Szlam does not disclose each and every element of claim 1. Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Depending upon the status of the call the agent may specify that the call has been essentially completed or that the agent is on hold. *See for example*, U.S. Patent No. 5, 511,112, Szlam, abstract; Figure 1; Figure 6; column 7, lines 23-24; column 17; lines 50-67. Szlam does not disclose identifying a context for a call as claimed in claim 1 of the present application that includes detecting a call request for a call and requesting a context for said call, wherein said context indicates whether an on behalf of action is invoked for said call. In fact, Szlam does not even mention "requesting a context for a call" or a "context indicates whether an on behalf of action is invoked for said call." Because Szlam does not disclose each and every element of the claim 1, Szlam does not anticipate claim 1 of the present application. The rejection should be withdrawn, and claim 1 should be allowed.

AUS920010833US1

The Office Action states that Szlam discloses an on behalf of action at column 12, lines 67 through column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually discloses placing an agent on hold and asking the agent to hold for another party to the call. Asking an agent to hold as disclosed in Szlam is not a call context that indicates whether an on behalf of action is invoked for the call as claimed in the present application. Because Szlam does not disclose each and every element of the claim 1, Szlam does not anticipate claim 1 of the present application. The rejection should be withdrawn, and claim 1 should be allowed.

Independent Claim 11

Independent claim 11 claims a method for determining a call context that includes receiving a call context request for a call, analyzing call context information associated with at least one from among a caller and a callee associated with said call, and inferring that an on behalf of action is invoked for said call from call context information. Szlam does not disclose each and every element of claim 11. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, analyzing call context information associated with at least one from among a caller and a callee associated with said call; and inferring that an on behalf of action is invoked for said call from call context information. In fact, Szlam does not even mention "inferring that an on behalf of action is invoked for said call from call context information". Because Szlam does not disclose each and every element of the claim 11, Szlam does not anticipate claim 11 of the present application. The rejection should be withdrawn, and claim 11 should be allowed.

The Office Action states that Szlam discloses an on behalf of action at column 12, lines 67 through column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually discloses placing an agent on hold and asking the agent to hold for another party to the call. Asking an agent to hold as disclosed in Szlam is not inferring that an on

AUS920010833US1

behalf of action is invoked for said call from call context information as claimed in the present application. Because Szlam does not disclose each and every element of the claim 11, Szlam does not anticipate claim 11 of the present application. The rejection should be withdrawn, and claim 11 should be allowed.

Independent Claim 14

Independent claim 14 claims a method for identifying parties to a call that includes detecting a call between at least two parties, detecting an on behalf of action invoked for said call, and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call. Szlam does not disclose each and every element of claim 14. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, "detecting an on behalf of action invoked for said call" and "informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call." In fact, Szlam does not even mention "detecting an on behalf of action invoked for said call" and "informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call." Because Szlam does not disclose each and every element of the claim 14, Szlam does not anticipate claim 14 of the present application. The rejection should be withdrawn, and claim 14 should be allowed.

The Office Action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually discloses placing an agent on hold and asking the agent to hold for another party to the call. Asking an agent to hold as disclosed in Szlam is not identifying parties to a call that includes detecting an on behalf of action invoked for said call and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call as claimed in the present application. Because Szlam does not

AUS920010833US1

disclose each and every element of the claim 14, Szlam does not anticipate claim 14 of the present application. The rejection should be withdrawn, and claim 14 should be allowed.

Independent Claim 17

Independent claim 17 claims a method for determining a call context that includes receiving a call context request for a call, analyzing call context information associated with said call, and determining whether an on behalf of action is invoked for said call from said call context information. Szlam does not disclose each and every element of claim 17. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, "receiving a call context request for a call," "analyzing call context information associated with said call," and "determining whether an on behalf of action is invoked for said call from said call context information." In fact, Szlam does not even mention "call context," "call context request," or "on behalf of action." Because Szlam does not disclose each and every element of the claim 17, Szlam does not anticipate claim 17 of the present application. The rejection should be withdrawn, and claim 17 should be allowed.

The Office Action states that Szlam discloses an on behalf of action at column 12, lines 67 through column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose placing an agent on hold and asking the agent to hold for another party to the call. Asking an agent to hold as disclosed in Szlam is not determining whether an on behalf of action is invoked for said call from said call context information as claimed in the present application. Because Szlam does not disclose each and every element of the claim 17, Szlam does not anticipate claim 17 of the present application. The rejection should be withdrawn, and claim 17 should be allowed.

AUS920010833US1

Szlam Does Not Enable Each and Every Element
Of The Claims Of The Present Application

Not only must Szlam disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Szlam must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d at 273, 158 USPQ at 600. The meaning of *Hoeksema* for the present case is that unless Szlam places Applicants' claims in the possession of a person of ordinary skill in the art, Szlam is legally insufficient to anticipate Applicants' claims under 35 USC 102(b). Szlam does not place one of ordinary skill in the art in possession of independent claims 1, 11, 14, and 17.

Independent Claim 1

Independent claim 1 claims a method for identifying a context for a call that includes detecting a call request for a call and requesting a context for said call, wherein said context indicates whether an on behalf of action is invoked for said call. Szlam does not place one of skill in the art in possession of claim 1 of the present application. Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Depending upon the status of the call the agent may specify that the call has been essentially completed or that the agent is on hold. *See for example*, U.S. Patent No. 5, 511,112, Szlam, abstract; Figure 1;

AUS920010833US1

Figure 6; column 7, lines 23-24; column 17; lines 50-67. Szlam does not place one of skill in the art in possession of identifying a context for a call as claimed in claim 1 of the present application that includes detecting a call request for a call and requesting a context for said call, wherein said context indicates whether an on behalf of action is invoked for said call. In fact, Szlam does not even mention "requesting a context for a call" or a "context indicates whether an on behalf of action is invoked for said call." Because Szlam does not place one of skill in the art in possession of claim 1, Szlam does not anticipate claim 1 of the present application. The rejection should be withdrawn, and claim 1 should be allowed.

The Office Action states that Szlam discloses an on behalf of action at column 12, lines 67 through column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose placing an agent on hold and asking the agent to hold for another party to the call. Asking an agent to hold as disclosed in Szlam does not place one of skill in the art in possession of a call context that indicates whether an on behalf of action is invoked for the call as claimed in the present application. Because Szlam does not place one of skill in the art in possession of claim 1, Szlam does not anticipate claim 1 of the present application. The rejection should be withdrawn, and claim 1 should be allowed.

Independent Claim 11

Independent claim 11 claims a method for determining a call context that includes receiving a call context request for a call, analyzing call context information associated with at least one from among a caller and a callee associated with said call, and inferring that an on behalf of action is invoked for said call from call context information. Szlam does not place one of skill in the art in possession of claim 11. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, analyzing call context information associated with at least one from among a caller and a callee associated with said call; and inferring that an on behalf

AUS920010833US1

of action is invoked for said call from call context information. In fact, Szlam does not even mention "inferring that an on behalf of action is invoked for said call from call context information". Because Szlam does not place one of skill in the art in possession of claim 11, Szlam does not anticipate claim 11 of the present application. The rejection should be withdrawn, and claim 11 should be allowed.

The Office Action states that Szlam discloses an on behalf of action at column 12, lines 67 through column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually discloses placing an agent on hold and asking the agent to hold for another party to the call. Asking an agent to hold as disclosed in Szlam does not place one of skill in the art in possession of inferring that an on behalf of action is invoked for said call from call context information as claimed in the present application. Because Szlam does not place one of skill in the art in possession of claim 11, Szlam does not anticipate claim 11 of the present application. The rejection should be withdrawn, and claim 11 should be allowed.

Independent Claim 14

Independent claim 14 claims a method for identifying parties to a call that includes detecting a call between at least two parties, detecting an on behalf of action invoked for said call, and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call. Szlam does not place one of skill in the art in possession of claim 14. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, "detecting an on behalf of action invoked for said call" and "informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call." In fact, Szlam does not even mention "detecting an on behalf of action invoked for said call" and "informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated

AUS920010833US1

for said call.” Because Szlam does not place one of skill in the art in possession of claim 14, Szlam does not anticipate claim 14 of the present application. The rejection should be withdrawn, and claim 14 should be allowed.

The Office Action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually discloses placing an agent on hold and asking the agent to hold for another party to the call. Asking an agent to hold as disclosed in Szlam does not place one of skill in the art in possession of identifying parties to a call that includes detecting an on behalf of action invoked for said call and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call as claimed in the present application. Because Szlam does not place one of skill in the art in possession of claim 14, Szlam does not anticipate claim 14 of the present application. The rejection should be withdrawn, and claim 14 should be allowed.

Independent Claim 17

Independent claim 17 claims a method for determining a call context that includes receiving a call context request for a call, analyzing call context information associated with said call, and determining whether an on behalf of action is invoked for said call from said call context information. Szlam does not place one of skill in the art in possession of claim 17. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, “receiving a call context request for a call,” “analyzing call context information associated with said call,” and “determining whether an on behalf of action is invoked for said call from said call context information.” In fact, Szlam does not even mention “call context,” “call context request,” or “on behalf of action.” Because Szlam does not place one of skill in the art in possession of claim 17, Szlam does not anticipate claim 17 of the present application. The rejection should be withdrawn, and claim 17 should be allowed.

AUS920010833US1

The Office Action states that Szlam discloses an on behalf of action at column 12, lines 67 through column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually discloses placing an agent on hold and asking the agent to hold for another party to the call. Asking an agent to hold as disclosed in Szlam does not place one of skill in the art in possession of determining whether an on behalf of action is invoked for said call from said call context information as claimed in the present application. Because Szlam does not place one of skill in the art in possession of claim 17, Szlam does not anticipate claim 17 of the present application. The rejection should be withdrawn, and claim 17 should be allowed.

Relations Among Claims

Independent claims 5, 9, 12, 13, 15, 16, 31 and 45 claim system and computer program product aspects of the methods claimed in claims 1, 11, 14, and 17. Independent claims 5, 9, 12, 13, 14, 15, 16, 31 and 45 stand because independent claims 1, 11, 14, and 17 stand. Applicants therefore traverse individually the rejections of all independent claims 1, 5, 9, 11, 12, 13, 14, 15, 16, 17, 31 and 45. The rejections should be withdrawn and the claims should be allowed.

Dependent claims 2-4, 6-8, 10, 18-30, 32-44, and 46-49 depend respectively from independent claims 1, 5, 9, 11, 17, 31 and 45. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand. As such, Applicants traverse individually the rejections claims 2-4, 6-8, 10, 18-30, 32-44, and 46-49. The rejections should be withdrawn and the claims should be allowed.

AUS920010833US1

**REJECTIONS UNDER 35 U.S.C. § 103(a) OVER SZLAM,
BORLAND, AND FARRIS**

Claims 12-13, 15-16, 23-24, 31, and 37-38 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112). Claims 25-30, 39-44, and 49 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112) in view of Borland (U.S. Patent 6,178,230). Claims 50-54 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112) in view of Farris *et al.* (U.S. Patent No. 6,122,357). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed modification of Szlam or the proposed combination of Szlam with either Borland or Farris must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to modify Szlam or to combine Szlam with either Borland or Farris. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed modification of Szlam or the proposed combination of Szlam with either Borland or Farris. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, neither the modification of Szlam, nor the combinations of Szlam with either Borland or Farris establishes a prima facie case of obviousness. The rejection of claims 1-54 should therefore be withdrawn and the case should be allowed.

Szlam

Claims 12-13, 15-16, 23-24, 31, and 37-38 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112). To establish a

AUS920010833US1

prima facie case of obviousness under 35 U.S.C. § 103(a), the proposed modification of Szlam must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action relies only on the reasoning provided in the rejections under 35 U.S.C. § 102 for many of the elements and limitations in Applicants' claims rejected under 35 U.S.C. § 103(a) over Szlam. As explained above, however, Szlam does not disclose the elements of Applicants' claims as described in the rejections under 35 U.S.C. § 102. Szlam therefore does not teach or suggest all of Applicants' claim limitations, and the Office Action does not establish a prima facie case for obviousness. The rejections are improper and should be withdrawn.

In addition, to establish a prima facie case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to modify Szlam. Moreover, the Examiner must explicitly point to the teaching within Szlam suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The Office Action states no rationale for motivation to modify Szlam other than the assertion at pages 4 and 5:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Szlam's controller to include an inference server for the purpose of storing and retrieving the context information to infer that a call includes an on behalf of action.

The Examiner does not cite Szlam or any other reference to support the assertion that modifying Szlam would have been obvious to one skilled in the art. Absent such a showing, the rejection is improper and should be withdrawn. As such, the Office Action does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

AUS920010833US1

Szlam and Borland

Claims 25-30, 39-44, and 49 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112) in view of Borland (U.S. Patent 6,178,230). Claims 25-30, 39-44, and 49 depend respectively from independent claims 17, 31, and 45. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Szlam does not disclose or suggest each and every element of the independent claims and no other references refer to the elements of the independent claims, the proposed combination of Szlam and Borland cannot possibly disclose or suggest each and every element of dependent claims 25-30, 39-44, and 49. The Office Action therefore does not establish a prima facie case for obviousness. The rejections are improper and should be withdrawn.

In addition, to establish a prima facie case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine Szlam and Borland. Moreover, the Examiner must explicitly point to the teaching within Szlam or Borland suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The Office Action states no rationale or motivation to combine Szlam and Borland other than the assertion at page 6:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of accessing on behalf of filtering preferences, as taught by Borland, in Szlam's system in order to determine the identity or filter out the person who placing or answer the call on behalf of the other.

AUS920010833US1

The Examiner does not cite Szlam, Borland, or any other reference to support the assertion that combining Szlam and Borland would have been obvious to one skilled in the art. Absent such a showing, the rejection is improper and should be withdrawn. As such, the Office Action does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to the substance of Borland, Borland actually teaches away from on behalf of actions as claimed in the present invention. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Borland discloses an individualized distinctive telephone ring to identify a particular callee. Borland at column 3, lines 60-65. The telephone ring is individualized and distinctive for a particular callee and therefore is an action on behalf of the callee—not an action on behalf of another. As such, Borland teaches away from actions on behalf of others by teaching telephone rings individualized for a particular callee. Because Borland teaches away from on behalf of actions, the proposed combination of Szlam and Borland cannot support a prima facie case of obviousness. The rejection of Applicants' claims are improper and should be withdrawn.

Szlam and Farris

Claims 50-54 stand rejected under 35 U.S.C § 103(a) as unpatentable over Szlam (U.S. Patent No. 5,511,112) in view of Farris, *et al.* (U.S. Patent No. 6,122,357). To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Szlam and Farris. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). In support of an obviousness rejection, the Examiner must explicitly point to the teaching within Szlam or Farris suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re*

AUS920010833US1

Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The Office Action states no rationale for motivation to combine Szlam and Farris other than the assertion at page 7:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporated the feature of graphically displaying at least one on behalf of party authorized for a party utilizing a telephony device and updating a context for a call based on the selection of the on behalf of party, in Szlam's system, in order to have the latest on behalf of action of the call on the context.

The Examiner, however, does not cite Szlam, Farris, or any other reference to support the assertion that combining Szlam and Farris would have been obvious to one skilled in the art. Absent such a showing, the rejection is improper and should be withdrawn. As such, the combination of Szlam and Farris cannot support a prima facie case of obviousness and the rejections should be withdrawn.

In addition, to establish a prima facie case of obviousness under 35 U.S.C. § 103, the proposed combination of Szlam and Farris must disclose all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 50 claims a "method for controlling a telephony device," including "graphically displaying at least one on behalf of party authorized for a party utilizing a telephony device; and detecting a selection from among said at least one on behalf of party; and automatically updating a context for a call to indicate an on behalf of action invoked by said party for said selection from among said at least one on behalf of party." Neither Szlam nor Farris discloses graphically displaying at least one on behalf of party authorized for a party utilizing a telephony device, and detecting a selection from among said at least one on behalf of party, and automatically updating a context for a call to indicate an on behalf of action invoked by said party for said selection from among said at least one on behalf of party as claimed in claim 50. As mentioned above, Szlam

AUS920010833US1

discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Depending upon the status of the call the agent may specify that the call has been essentially completed or that the agent is on hold. *See for example*, U.S. Patent No. 5, 511,112, Szlam, abstract; Figure 1; Figure 6; column 7, lines 23-24; column 17; lines 50-67. Specifying that the call has been essentially completed or that the agent is on hold does not teach or suggest graphically displaying at least one on behalf of party authorized for a party utilizing a telephony device, and detecting a selection from among said at least one on behalf of party, and automatically updating a context for a call to indicate an on behalf of action invoked by said party for said selection from among said at least one on behalf of party as claimed in claim 50. In fact, Szlam does not even once mention, for example, "an on behalf of party." The combination of Szlam and Farris therefore cannot teach or suggest the elements and limitations of claim 50 of the present application. The combination of Szlam and Farris cannot establish a prima facie case of obviousness and the rejections should be withdrawn.

Farris does not correct the deficiencies of Szlam. Farris discloses double voice identification of calling and answering parties. *See for example*, U.S. Patent No. 6, 122, 357, Farris, abstract. Farris does not disclose graphically displaying at least one on behalf of party authorized for a party utilizing a telephony device, and detecting a selection from among said at least one on behalf of party, and automatically updating a context for a call to indicate an on behalf of action invoked by said party for said selection from among said at least one on behalf of party. In fact, Farris does not even once mention, for example, "an on behalf of party." The combination of Szlam and Farris therefore cannot teach or suggest the elements and limitations of claim 50 of the present application. The combination of Szlam and Farris cannot establish a prima facie case of obviousness and the rejections should be withdrawn.

Dependent claims 51-54 depend respectively from independent claim 50. The dependent claims include each and every limitation of the independent claim from which they

AUS920010833US1

depend. The dependent claims stand because their respective independent claims stand. As such, Applicants traverse individually the rejections claims 50-54. The rejections should be withdrawn and the claims should be allowed.

CONCLUSION

Claims 1-11, 14, 17-22, 32-36, and 45-48 stand rejected under 35 U.S.C § 102(b) as being anticipated by Szlam. For the reason set forth above, Szlam does not anticipate Applicants' claims. Claims 12-13, 15-16, 23-24, 31, and 37-38 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam. Claims 25-30, 39-44, and 49 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam in view of Borland. Claims 50-54 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam in view of Farris et al. For the reasons set forth above, however, Szlam, alone or in combination with Borland or Farris, fails to establish a prima face case of obviousness. The rejections of all claims 1-54 should be withdrawn, and the claims should be allowed. Applicants respectfully traverse each rejection individually of claims 1-54 and request reconsideration of claims 1-54 in light of the present remarks.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: January 19, 2006

By: _____

H. Artoush Ohanian
Reg. No. 46,022
Biggers & Ohanian, LLP
P.O. Box 1469
Austin, Texas 78767-1469
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS